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Applicant	Sally J. Coxe
Correspondence Address	William L. Bartow DLA Piper US LLP Suite 49001650 Market Street Philadelphia PA 19103, PA 19013 UNITED STATES ip.phil@dlapiper.com
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Filer's Name	William L. Bartow
Filer's e-mail	ip.phil@dlapiper.com
Signature	/william l. bartow/
Date	01/04/2008

TRADEMARK

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Attorney : John C. Boone
Law Office : 104
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One Liberty Place, Suite 4900
1650 Market Street
Philadelphia, PA 19103

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APPEAL BRIEF

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INTRODUCTION

Applicant/Petitioner, Sally J. Coxe, an individual, appeals the decision of the Examining Attorney refusing registration of her application Serial Number 78/877,323 to register the mark BONOBO BREW. The refusal is based on Lanham Act Section 2(d) in light of Registration No. 3,000,676 for the word mark BONOBO'S ("Cited Registration") owned by Bonobo's, LLC, Ltd. ("Registrant").

Applicant respectfully requests that this Board reverse the PTO's finding in this regard because Applicant's BONOBO BREW mark is not likely to cause confusion with BONOBO'S as to source, affiliation or sponsorship. There is no likelihood of confusion because the marks are sufficiently different and the goods in question are unrelated. Applicant's BONOBO BREW mark has an additional word and lacks the possessive ending of the Cited Registration. Applicant's goods are specifically "coffee and beer sold in connection with raising funds for and awareness of the Bonobo and its habitat," in international classes 30 and 32. These goods are not related to the Cited Registration's "fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream (classes 29 and 30) and restaurant services (class 43)." Further, Registrant's restaurant is a vegetarian restaurant and, therefore, does not and will not serve coffee or beer. Because of the differences between the relevant marks and goods, no likelihood of confusion exists.

FACTS AND PROCEDURAL HISTORY

Applicant, Sally J. Coxe is the President of the Bonobo Conservation Initiative ("BCI"). BCI is a non-profit, 501-(c)(3) organization based in Washington, D.C. and the Democratic Republic of the Congo. BCI's mission is to promote conservation of the Bonobo, a near extinct chimpanzee that lives in the tropical forest of the Congo Basin. Funding is crucial for conserving the Bonobo and its habitat. Applicant seeks registration of BONOBO BREW in connection with coffee and beer

because it intends to sell these goods to raise funds for conserving the Bonobo and its habitat.

Applicant's BONOBO BREW mark for "coffee and beer sold in connection with raising funds for and awareness of the Bonobo and its habitat," in classes 30 and 32, has been finally rejected as likely to cause confusion with the mark BONOBO'S for "fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream (classes 29 and 30) and restaurant services (class 43)."

The BONOBO'S mark is actually used publicly as "Bonobo's Vegetarian" or "Bonobo's Restaurant" in conjunction with a vegetarian restaurant in New York, NY that does not serve coffee or beer because such items are contrary to the restaurant's "eco-friendly food" philosophy.

Applicant filed its application to register the word mark BONOBO BREW on the Principal Register, on May 5, 2006. The application listed "beer, fruit juice beverages and vegetable juice beverages" in International Class 032. A first Office Action was issued on October 12, 2006. The PTO refused registration under Section 2(d) because Applicant's BONOBO BREW mark allegedly was likely to cause confusion with the Cited Registration. In addition, the word "juices," which was used to describe some of the applicant's goods, was allegedly indefinite. On April 12, 2007, Applicant filed a timely response to the first Office Action. In the Response, Applicant amended the description of goods and provided arguments and evidence as to why BONOBO BREW is not likely to cause confusion with the Cited Registration. The PTO withdrew the indefiniteness rejection but on May 8, 2007, it issued a final Office Action, making the rejection under Section 2(d) with respect to both classes of goods in the application final. On November 8, 2007, Applicant filed a timely response to the final Office Action with a Notice of Appeal. In addition to arguing against the Section 2(d) refusal Applicant amended the goods and services by canceling "fruit juice beverages and vegetable juice beverages" and adding "sold in connection with raising funds for and awareness of the Bonobo and its habitat." Thus, the listing of goods for which registration of BONOBO BREW

is sought now reads “coffee and beer sold in connection with raising funds for and awareness of the Bonobo and its habitat.”

ISSUE

The issue to be decided on appeal is whether Applicant’s BONOBO BREW mark for “coffee and beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat,” in classes 30 and 32, is likely to cause confusion with BONOBO’S for “fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream (classes 29 and 30) and restaurant services (class 43).”

ARGUMENT

A refusal to register under Lanham Act Section 2(d) requires that there be a likelihood that the public will be confused by the Applicant’s mark and that this likelihood of confusion be probable, not simply possible. *American Steel Foundries v. Robertson*, 269 US 372 (1926). In determining whether an Applicant’s mark is likely to cause confusion with a registered mark, the Board considers the *DuPont* factors.¹ The factors at issue in this appeal are: (1) the relatedness of the goods and services; (2) the similarity or dissimilarity of the marks; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing; and (5) the number and nature of similar marks in use on similar goods.

With respect to the similarity in the marks and goods and services, to sustain a Section 2(d) refusal where the respective goods are not competitive and the marks are not identical the PTO must prove that: (1) the goods of the respective parties are “so related” that an ordinarily prudent purchaser will likely be confused as to source, connection or sponsorship; and (2) the marks themselves are confusingly similar. 24 J. Thomas McCarthy, *McCarthy on Trademarks*, § 24:27 (4th

¹ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973).

ed. 1992). It appears that the PTO has found that the goods are not competitive because it applied the “related to” standard under Section 2(d).

Applicant’s BONOBO BREW mark is not identical to the Cited Registration’s BONOBO’S mark. In addition, Applicant’s specific goods of “coffee and beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat” are not competitive with the Cited Registration’s listed goods, namely, “fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream and restaurant services.” *See United States v. E.I. Du Pont de Nemours & Co.*, 351 US 377 (1956) (Goods are not competitive unless they are “reasonably interchangeable.”) Further, with the deletion of “fruit juice beverages and vegetable juice beverages” from the recitation of goods, none of the respective goods or services overlap.

I. APPLICANTS GOODS ARE NOT RELATED TO THE GOODS AND SERVICES OF THE CITED REGISTRATION

Applicant’s goods are limited to two specific beverages; coffee and beer, which are in Classes 30 and 32, respectively. The application recites specifically that the beverages are sold in connection with raising funds for and awareness of the Bonobo and its habitat. The Cited Registration’s goods are limited to only foods, namely, fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream in classes 29, 30 and 31. The recited services are restaurant services in class 43. For the following reasons, Applicants goods are not related to the goods and services recited in the Cited Registration.

A. Applicant’s Beer and Coffee Are Not Related To Registrant’s Fruits, Vegetables, Various Seeds, Crackers, Cookies, Cakes and Ice-Cream

As a preliminary matter, the burden of proving likelihood of confusion is on the United States Patent and Trademark Office. *In re First Union Corporation*, Serial No. 75/514,466, 2002 TTAB

LEXIS 149, *3 (TTAB 2002). Here, the PTO's finding that beer and coffee are related to the Cited Registration's goods of fruits, vegetables, seeds, crackers, cookies, cakes and ice-cream is based solely on its finding that "all foods and beverages are somewhat related" because "[a]ll are produced for the same purpose of dietary consumption . . ." See Final Office Action mailed May 8, 2007. As provided in detail below, this is not the proper standard for whether food and beverage goods are related. The standard is whether the goods are known to be complementary. Here, the PTO did not find that the respective goods are related because they are so known to be consumed together because they complement each other. Therefore, the PTO has not met its burden of showing that the respective goods are related.

The goods recited in the application are not related to the Cited Registration's goods. As provided above, beverage and food goods are related, for likelihood of confusion purposes, if they are known to be "complementary." See 24 J. Thomas McCarthy, *McCarthy on Trademarks*, § 24:48 (4th ed. 1992). The complementary standard is not whether the foods or beverages *may* be consumed together. It is whether the foods or beverages *are often used in combination and are consumed together to complement each other*. *7-Eleven, Inc. v. HEB Grocery Company, LP*, Opposition No. 91162178, 2007 TTAB LEXIS 74, *16-17 (TTAB 2007) (UNPUBLISHED) (citing *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565 (Fed. Cir. 1984)); see also *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (mere fact that two goods may be used together does not demand a finding that confusion is likely). Therefore, that two goods are used together, does not in itself, justify a finding of relatedness. *Shen*, 393 F.3d at 1244. "The test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue can be related in the mind of the consuming public as to the origin of the goods." *Id.*

As a result, it has been held that bread and cheese are related as are wine and cheese. These respective combinations are often used in combination and it is well known that they are consumed together to complement each other. *See e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565; *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280 (9th Cir. 1992). Conversely, the Board has held that drinking water and heated frozen food entrees are not related, even though they may be consumed together, because water it is not used in combination with the entree in the same way bread and cheese are used together to complement each other. *7-Eleven*, 2007 TTAB LEXIS 74, *15; *see also In re Mars, Inc.* 741 F.2d 395 (Fed. Cir. 1984) (reversing the PTO's refusal to register CANYON for fresh citrus fruits after finding that this mark would not cause confusion with the registered CANYON mark for candy bars); *Vitarroz v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981) (finding no likelihood of confusion between BRAVO'S for crackers and BRAVOS for tortilla chips.)

As provided below, beer and coffee are not complementary with fruits, vegetables, seeds, crackers, cookies, cakes and ice-cream.

1. Applicant's Beer Is Not Related To Registrant's Fruits, Vegetables, Various Seeds, Crackers, Cookies, Cakes and Ice-Cream

It has been held that beer is not related to non-alcoholic goods. In *Swedish Beer Export Co. v. Canada Dry Corp.*, the CCPA found that the mark SKOLA for soft drinks is not likely to cause confusion with the mark SKOL for beer because "soft drinks and beer are goods whose differences are clearly recognized by would-be purchasers." *See* 469 F.2d 1096, 1097 (C.C.P.A. 1972). Similarly, the Board has found that water is not related to beer and ale. *Alaskan Brewing & Bottling Co. v. John Mason Oney*, Opposition No. 86,988, 1996 TTAB LEXIS 79, *5 (TTAB 1996). In *Alaskan Brewing*, the Board found that beer and water both are beverage products which may be sold in the same retail stores to the general consuming public but that "beer and ale, on the one hand, and glacier water, on the other, are specifically different products with specifically different uses, and

there is no evidence that these differing types of products ever emanate from a single source, much less that consumers would expect them to.” *Id.*

The goods in question in *Alaskan Brewing* and *Swedish Beer* were more closely related than respective goods are in this case. In *Alaskan Brewing* and *Swedish Beer* the respective goods were at least both beverages.² Further, in *Alaskan Brewing*, the goods in question were in the same class. Here, the Registrant’s goods consist only of foods. Beer is in Class 32, while Registrant’s goods are only foods, none of which are in this class. None of Applicant’s goods are in this class.

In addition, like the bottled water and beer in *Alaskan Brewing*, beer and fruits, vegetables, various seeds, crackers, cookies, cakes and ice-cream are specifically different products with specifically different uses, and there is no evidence that these differing types of products ever emanate from a single source, much less that consumers would expect them to. Beer is a beverage marketed and sold to adult consumers. Cookies, cakes and ice-cream are desserts that are also marketed toward children and adults and are generally sold in different areas of a supermarket than alcoholic beverages. (In many cases, these goods are sold in completely different stores; beer being sold in a liquor store and Cookies, cakes and ice-cream sold in a bakery.) There has been no evidence that a seller of fruits, vegetables, crackers, cookies, etc. will likely, naturally, expand into selling beer. In particular here, and discussed in more detail below, Registrant’s restaurant is a vegetarian restaurant and, therefore, does not and will not serve beer. *See e.g.*, Exhibit “A” of November 8, 2007 Response to the final Office Action (“Response”); *see also*, specimens submitted on June 3, 2003 in Serial No. 78/257,824 (application that became the Cited Registration), showing the Bonobo’s mark used on “Pure Raw Organic Coconut Oil” and on a menu featuring only raw

² In addition, in *Swedish Beer*, the parties’ marks were identical but for one letter added at the end of the applicant’s mark. Here, the Applicant’s mark is missing an “s” and contains an entire additional word, “BREW.”

foods. Finally, beer is not known to be consumed with and complementary to fruits, vegetables, seeds, crackers, cookies, cakes and ice-cream and there has been no evidence presented by the PTO with respect to this issue.

2. Applicant's Coffee Is Not So Related To Registrant's Fruits, Vegetables, Various Seeds, Crackers, Cookies, Cakes and Ice-Cream

With respect to Registrant's fruits, vegetables and seeds (which come from fruits and vegetables), the Board has found that fruit-based products such as fruit juice are not related to coffee and food and beverages sold in coffee house-type restaurants. In *Rudolf Wild GmbH & Co. KG v. I Uno Espresso, Inc.*, the Board found that the mark CAPRI for "whole and ground coffee beans, espresso and other coffee beverages" was not likely to cause confusion with the registered mark CAPRI SUN for fruit drinks after finding that coffee is unrelated to fruit drinks. See Opposition No. 93,813, 1998 TTAB LEXIS 128, *12-14 (TTAB 1998) (UNPUBLISHED). The Board found that coffee and fruit drinks share only "two common characteristics: (1) Both are beverages (or can be made into beverages); and (2) both can be purchased in grocery stores and supermarkets." See *Rudolf Wild*, Opposition No. 93,813, 1998 TTAB LEXIS 128, *12-14 (TTAB 1998). It then stated, "in all other respects, the products are different." *Id.* at 15. In particular, the Board found that "[the respective goods] are sold in different sections of grocery stores and supermarkets; they are primarily advertised and marketed to entirely different age groups, [coffee being generally marketed and sold to adults]; . . . they come in different packaging in that there is no evidence that in the United States, espresso and other coffee products are typically sold in supermarkets and grocery stores in ready-to-drink form as are juice drink beverages." *Id.* at *13, 15-16 (citing *National Distillers Corp. v. William Grant & Son, Inc.*, 505 F.2d 719 (CCPA 1974) and stating, "coffee products and juice drink beverages are more dissimilar than are cocktails made with brandy and brandy itself.")

Similarly, in *In re Island Oasis Frozen Cocktail Company, Inc.*, the Board reversed the PTO's refusal to register ISLANDER for concentrates for making frozen drinks and smoothies and smoothie beverages consisting of fruit base based on a likelihood of confusion with ISLANDER COFFEE HOUSE for restaurant services that were, in effect, a coffee house. See Serial No. 75/883,870, 2002 TTAB LEXIS 319, *6 (TTAB 2002)) (UNPUBLISHED).

With respect to Registrant's crackers, cookies, cakes and ice-cream, the Board has often found that such goods are not related to coffee and tea. In *Chock Full O' Nuts Corp. v. Chock-A-Block, Inc.*, the applicant's goods were "cookies" and the opposer's goods were coffee, tea and cocoa; cakes, pie and doughnuts; and restaurant and coffee bar services. The Board found that applicant's cookies are most similar or closely related to the bakery items, i.e., "cakes, pie and doughnuts," and not the coffee and tea. 2000 TTAB LEXIS 337*7-8 (TTAB 2000) (UNPUBLISHED) In addition, the Board refused to find that cookies are related to coffee and coffee bar services and would not take judicial notice that coffee and baked goods are complementary. *Id.* (citing *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 233 (TTAB 1977)).

With respect to fruits, vegetables and seeds, the goods in question in *Rudolf Wild* and *Island Oasis* were more closely related than respective goods are in this case. In *Rudolf Wild* and *Island Oasis* the respective fruit goods were at least both beverages. Here, the Registrant's goods consist only of foods. In addition, coffee is marketed toward adults only while fruits, vegetables, various seeds, crackers and cookies, cakes and ice-cream, especially, are also marketed toward children and young adults. Coffee is generally sold in different sections of grocery stores than Registrant's goods and likely comes in packaging different from the packaging of Registrant's goods (indeed, fruits and vegetables, often, are not packaged at all). See *Rudolf Wild, supra*.

Further, it has been held that coffee and the aforementioned goods of the Cited Registration are generally not complementary. *See e.g., Chock Full O' Nuts, supra*. Even assuming *arguendo* that coffee may sometimes be consumed with ice cream, cookies or cake, these items are not often used in combination and are not consumed together *to complement each other*. *See 7-Eleven, supra* (emphasis added). At the very least, to show that Applicant's coffee is consumed with Registrant's baked goods, something more must be shown than what was provided in the PTO's Office Actions. Finally, as stated above with respect to beer and as discussed in more detail below, Registrant's restaurant is a vegetarian restaurant that does not and would not serve coffee. *See e.g., Exhibit "A"* of November 8, 2007 Response, specimen submitted in Serial No. 78/257,824. This also means, there is no likelihood that Registrant will naturally expand into selling coffee.

B. Applicant's Beer and Coffee Are Not So Related To Registrant's Restaurant Services

Aside from Applicant's goods being unrelated to Registrant's goods, Applicant's goods are not related to Registrant's restaurant services. It is well settled, that even where respective marks are similar, confusion is not always likely when a similar mark is used on restaurant services and food products. *See McCarthy* § 24:48 (citing *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766 (Fed. Cir. 1993)). "Something more" than a mere conflict between a use on food and a use on restaurant services is needed, such as use on a food product of the type *likely to be marketed by a restaurant*. *See Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 1236 (CCPA 1982). For example, in *Steve's Ice Cream v. Steve's Famous Hot Dogs* the Board found no likelihood of confusion between similar marks, one for restaurant services and the other for ice cream, because there was no evidence that the restaurant made or sold ice cream under the same mark in connection with which it rendered restaurant services. *See Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1479 (TTAB 1987). Similarly, courts have found that a mark for goods is not likely to cause confusion

with a similar mark for a store even if the store may sell the good or similar goods. For example, the Third Circuit found that the mark FAMILY CIRCLE, for discount department stores, was not likely to cause confusion with the registered mark FAMILY CIRCLE for magazines even though the magazines could have been sold in the department store. *See Family Circle, Inc. v. Family Circle Associates, Inc.*, 332 F.2d 534, 541 (3d Cir. 1964). Similarly, the Seventh Circuit found no likelihood of confusion between ZAZU for hair salon services and ZAZU for hair care products even though the products could be sold in the salon. *See Zazu Designs v. L'Oreal, S.A.* 979 F.2d 499, 509 (7th Cir. 1992) (superseded by statute on other grounds).

Thus, to show that food and beverage goods are related to the restaurant services, the PTO must provide “something more” than simply the fact that the registration lists restaurant services and the application seeks to register food and/or beverages. Nevertheless, in the Office Actions, it appears that the PTO found that Applicant’s goods are related to Registrant’s restaurant services simply because Applicant’s goods are beverages and Registrant’s services are restaurant services. In particular, in support of its finding in this regard, the Office Actions provide nothing more than “it is *conceivable* that the applicant’s beverages *could* be served at restaurants *like the registrants*” and that “[f]ood products and food-related services have been considered related goods and services under Section 2(d).” (Emphasis added). The Office Actions did not provide any support for why consumers would believe that Applicant’s goods come from the Registrant’s particular restaurant. The PTO’s findings are not enough to meet the “something more” standard and, therefore, it is respectfully submitted that the PTO has not met its burden of showing a likelihood of confusion. In addition, here, and discussed in more detail below, Registrant’s restaurant is a self-proclaimed “eco-friendly,” vegetarian restaurant and, therefore, does not and will not serve beer. *See e.g.*, Exhibit “A” of November 8, 2007 Response to the final Office Action (“Response”); *see also*, specimens

submitted on June 3, 2003 in Serial No. 78/257,824 (application that became the Cited Registration), showing the Bonobo's mark used on "Pure Raw Organic Coconut Oil" and on a menu featuring only raw foods.

Nevertheless, with respect to beer and restaurant services, in particular, the Federal Circuit has found that beer is not so related to restaurant services unless the prior registration for restaurant services specifically recites that *brewpub-type services* are sold under the mark. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1346 (Fed. Cir. 2003); *In re Kluckers, Inc.*, Serial No. 78/322,373, 2005 TTAB LEXIS 551, 14-15 (TTAB 2005) (UNPUBLISHED) ("the Coors Brewing court explained that the case would have been different 'if the registrant's mark had been for a brewpub or for restaurant services and beer'.") In *Coors*, the Federal Circuit found that it was improper for the PTO to reject an application for registration of beer under the mark BLUE MOON because of a prior registration for BLUE MOON for restaurant services. The "something more" was missing because the evidence indicated that it was quite uncommon for a restaurant and a beer to share the same trademark. *See McCarthy* § 24:48; *In re Coors Brewing Co.*, 343 F.3d at 1346 (finding that less than 1 in 500 restaurants sell their own private label beer). The Federal Circuit noted that a mark for beer may cause confusion with the mark for a prior registration for restaurant services only *if the prior registration recites brewpub services*. *See id.* at 1347.

Notably, in *Coors*, the Federal Circuit stated that its reasoning also extends to all foods and beverages including, specifically, coffee. It stated, "some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant." *Id.* at 1346. The court then stated

in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting *would be to limit dramatically the number of marks that could be used by producers of foods and beverages.*

In re Coors Brewing Co., 343 F.3d at 1346 (emphasis added).

In that regard, the Federal Circuit has also found that that tea, which is similar to coffee, is not so related to restaurant services, without more. *See Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982) (finding no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA PARTY for “restaurant services.”).

Here, Applicant’s beer is in class 32 and its coffee is in class 30. The Cited Registration’s restaurant services are in class 43. The Cited Registration does not recite brewpub or microbrewery related services nor does it recite, specifically, beer or coffee. And, there is no evidence that the restaurant sells a private label beer or coffee. Therefore, under *Coors*, the Cited Registration’s restaurant services are not related to Applicant’s beverages. In addition, in *Coors*, the respective BLUE MOON marks were identical where as here, the marks are not. To deny registration of Applicant’s coffee and beer simply because a registration recites restaurant services runs contrary to the Federal Circuit’s holding in *Coors* and the policy behind that holding.

Further, the evidence is contrary to the Registrant’s restaurant selling coffee or beer. *See Steve’s Ice Cream, supra*. Registrant’s restaurant sells only raw foods and therefore it would not sell beer or coffee. As such, these products would not be in the “normal fields of expansion” as provided in the Action. The specific nature of Registrant’s restaurant is evidenced by the specimens submitted by Registrant during prosecution of its trademark application, which show the Bonobo’s mark used on “Pure Raw Organic Coconut Oil” and on a menu featuring only raw foods. In addition, Registrant’s website states that it sells only “raw” “eco-friendly” foods. *See* pages from

<http://www.bonobosrestaurant.com>, attached as Exhibit "A" to November 8, 2007 Response. With respect to Bonobo's Restaurant's food, the website states that "[a]ll vitamins, minerals and other food components are not changed by heat." *Id.* In addition, nothing is heated over 116 degrees Fahrenheit in raw food cooking (*see* Exhibit "B" of November 8, 2007 Response). Beer is prepared from malted barley among other ingredients. The malt is prepared by a process that includes mashing, or heating a barley preparation in water at 105-170 degrees Fahrenheit for some time. *See* <http://en.wikipedia.org/wiki/Brewing> (Exhibit "C" of November 8, 2007 Response). Further, bottled beer is generally pasteurized to remove microbiological organisms by heating it to at least 140 degrees for some minutes, or much higher temperatures for 15-30 seconds. *See* <http://www.micromatic.com/draft-keg-beer-edu/beer-pasteurization-aid-123.html> (Exhibit "D" of November 8, 2007 Response). Coffee beans are necessarily roasted before they are ground, then the beverage is prepared with near-boiling water. *See* http://en.wikipedia.org/wiki/Coffee_roasting (Exhibit "E" of November 8, 2007 Response). All of these processes and products are thus antithetical to Registrant's stated philosophy, regarding selling only vegetarian, in particular raw, foods.

For the foregoing reasons, Applicant's coffee and beer are not related to Registrant's foods and restaurant services.

II. THE RESPECTIVE MARKS ARE NOT CONFUSINGLY SIMILAR

In determining whether marks are confusingly similar, the marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 851 (Fed. Cir. 1992); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 887 (Fed. Cir. 1986). Where the goods and services are directly competitive, the degree of similarity required to prove a

likelihood of confusion is less than in the case of dissimilar products. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877 (Fed. Cir. 1992).

A likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. More or less weight may be given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 1058, (Fed. Cir. 1985). The disclaimed elements of a mark are relevant to the assessment of similarity. *Shen*, 393 F.3d at 1243 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993)). This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed. *Id.*

Here, as provided above, Applicant's goods are not competitive with, identical or related to the Cited Registration's goods or services. Therefore, more similarity between the marks is required before a likelihood of confusion can be found.

Further, the marks are dissimilar in sight, sound and meaning. Applicant's mark is BONOBO BREW; the cited Registration is BONOBO'S (generally pronounced "Bono-boze"). Applicant's mark is a two word, four syllable mark, and the cited mark is a one word, three syllable mark. The two-word pronunciation pattern of BONOBO BREW thus differs greatly from the single-word pronunciation of the cited mark. The word "BONOBO" is also used as an adjective modifying "BREW" in the Applicant's mark, while the cited mark is presented as a possessive noun with no modified noun. In BONOBO BREW the pronunciation emphasis is on "brew" whereas in the Cited Registration, the emphasis is on "boze." Further, the Cited Registration's mark includes an apostrophe "s"; a possessive, indicating that it is used in connection with foods that are similar to what is included in a Bonobo's diet.

BONOBO'S, as used in Registrant's mark, is merely descriptive, and therefore inherently weak and not entitled to wide protection. As indicated in Exhibit "A" of the November 8, 2007 Response, the foods served in Registrant's restaurant (Registrant's only current place of business using any "bonobo" name) is based on the actual diet of the chimpanzee species known as "bonobo." Consequently BONOBO'S simply describes the type of fare at Registrant's restaurant, namely, food eaten by bonobos. Clearly this impression is not conveyed by Applicant's BONOBO BREW, as one would never think that a bonobo drank beer or coffee. To the contrary, BONOBO is an arbitrary term with respect to Applicant's beer and coffee.

Alternatively, the CCPA has found that where a registered mark consists of one arbitrary word and the mark sought-to-be-registered includes that word followed by a second word, the marks can be sufficiently dissimilar despite similar goods and services. In particular, the CCPA found that the mark PEAK PERIOD, as applied to personal deodorant, did not so resemble the previously used mark PEAK, as applied to a dentifrice, as to be likely to cause confusion. *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (CCPA 1970).

It appears that the case for confusion was much stronger in *Colgate-Palmolive* than here. In *Colgate-Palmolive*, the respective marks' first word was identical; PEAK and the goods were closely related. Here, the respective first words are not identical. Registrant's mark is BONOBO'S, Applicant's is BONOBO BREW. In addition, here, the goods and services are not related for the reasons provided above.

Accordingly, the substantial differences between the sight, sound and meaning of the marks involved points away from likelihood of confusion.

III. APPLICANT'S GOODS AND THE GOODS OF THE CITED REGISTRATION TRAVEL IN DIFFERENT CHANNELS OF TRADE

Consumers are not likely to be confused as to the source of origin of Applicant's beer and

coffee because Registrant's foods are sold only through its restaurant. In the restaurant, customers order food and the food is served by wait-staff or counter attendants. These individuals provide a second level of explanation regarding the goods. Conversely, Applicant's goods are to be sold in supermarkets and through BCI itself. Therefore, the respective goods are not likely to be encountered by the same purchasers.

IV. NO CONFUSION IS LIKELY BECAUSE THE PURCHASERS OF THE RESPECTIVE GOODS AND SERVICES ARE SOPHISTICATED

Consumers of Registrant's goods and services are not "ordinary" but are relatively discriminating purchasers, which makes it less likely that consumers would be confused as to the source of Applicant's goods. Registrant's restaurant serves only raw, "eco-friendly" food. *See* Exhibit "A" of November 8, 2007 Response. There are a relatively few number of such restaurants and consumers of raw food are very careful about selecting a restaurant that serves food and beverages that meet their strict dietary requirements (for example, to avoid accidental tainting by meat products). In fact, many consumers of only raw foods consider products such as beer and coffee to be akin to "poison." *See e.g.*, <http://www.beyondveg.com/tu-j-l/raw-cooked/raw-cooked-1a.shtml> (Exhibit "F" of November 8, 2007 Response). Certainly, a consumer, who after careful consideration of his or her particular diet, patronizes Registrant's raw, eco-friendly food restaurant would not be confused into believing that Bonobo Brew, under which beer and coffee are sold, originates from the same source as the restaurant or other goods. The care used in selecting a restaurant or foods based upon whether they meet certain dietary requirements is akin to the care used in selecting relatively expensive foods or restaurant services. *See e.g.*, *Barbecue Marx, Inc. v. 551 Ogden, Inc.*, 235 F.3d 1041 (7th Cir. 2000) (finding that consumers of relatively expensive restaurant services are relatively discriminating.) Further, as provided above, consumers of beer and coffee are adults.

Because consumers of Registrant's goods are relatively sophisticated, there is no reasonable possibility of confusion between Applicant's coffee and beer and Registrant's foods and restaurant services.

V. **THE CITED REGISTRATION IS ENTITLED TO LIMITED PROTECTION BECAUSE THERE ARE A NUMBER OF SIMILAR MARKS IN USE ON SIMILAR GOODS**

Registrant's mark is limited in scope because other "bonobo" marks co-exist on the principal register and in commerce. The mark BONOBO (Serial No. 76/647,660) has been allowed for food-related goods, namely, "reconfigurable mealtime accessory totes." This mark is virtually identical to Registrant's mark and claims arguably related goods and is much closer than Applicant's mark. However, these marks are able to co-exist on the register. In fact, Registrant's mark was not even cited against the BONOBO'S application during prosecution.

In addition, the marks of these respective entities will be able to co-exist especially given the fact that the Bonobo is an animal (like Eagle or Chicken). There are a great number of trademarks that are related to animals, for example, "Eagle" brand, that are able to co-exist. In particular, the mark "PANDA" for "Restaurant services, namely Chinese fast food restaurant and take out services" (Serial no. 78/776,425) has recently been allowed despite the earlier-filed "PANDA" for "beer," (Serial No. 78/651,858) which also was recently allowed. *See* Exhibit "G" of November 8, 2007 Response. PANDA for restaurant services and beer is arbitrary as BONOBO is here for similar goods.

Indeed, the co-existence of these PANDA marks show that it is contrary to public policy to allow an entity to preclude the use of the name of an animal for any and all food or beverage related goods simply because the mark or an arguably similar mark may be used for restaurant services. Aside from the aforementioned PANDA marks, there are other animal-related marks for similar

goods and services that co-exist. See e.g. Exhibit “H” of November 8, 2007 Response, THE LAUGHING GOAT (Reg. No. 3295291 for “Cafes; Coffee shops; Restaurant services” and THE NAKED GOAT (Reg. No. 3086746) for “CHEESE.” As provided above, the concern of marks for restaurants precluding an overly broad range of marks for food products was part of the basis of the Federal Circuit’s holding in *In re Coors Brewing Co.*

Further, there are other Bonobo marks that have been able to co-exist in commerce. For example, clothing is sold under the name “Bonobo.” See pages from <http://www.bonoboplanet.com/autumn-winter-07.php>, Exhibit “I” of November 8, 2007 Response.

VI. APPLICANT’S BONOBO BREW MARK IS A NATURAL OUTGROWTH OF ITS TRADE NAME “BONOBO CONSERVATION INITIATIVE”, WHICH IT HAS USED SINCE 1998

As provided above, Applicant is a not-for-profit organization incorporated in the District of Columbia on June 16, 1998 and granted 501(c)(3) status in April 1999. Applicant is dedicated to preserving the bonobo species and its habitat and has been using the trade name, Bonobo Conservation Initiative since 1998 and has used the web address bonobo.org since 2000. Both of these dates predate Registrant’s November 1, 2002 use of BONOBO’S. The BONOBO BREW mark is a natural outgrowth of the Bonobo Conservation Initiative trade name and web address, which further reduces any likelihood of confusion. In particular, the public has come to recognize the Bonobo Conservation Initiative marks as associated with BCI. The BONOBO’S mark has been able to co-exist with the Bonobo Conservation Initiative marks and will be able to co-exist, without confusion, with Applicant’s BONOBO BREW mark.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that its BONOBO BREW mark is not likely to cause confusion with the mark of the Cited Registration. Applicant’s goods are specifically

"coffee and beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat," in classes 30 and 32, which are unrelated to the Cited Registration's goods and restaurant services. Further, Registrant's specimens and other evidence clearly show that restaurant is a vegetarian restaurant with a particular philosophy regarding raw, "eco-friendly" foods and, therefore, does not and will not serve coffee or beer. For the foregoing reasons, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register BONOBO BREW under Section 2(d).

Respectfully submitted,

Date:

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William L. Bartow
Reg. No. 54,981
Attorney for Applicant

WLB/sh

DLA Piper US LLP
One Liberty Place
1650 Market Street, Suite 4900
Philadelphia, PA. 19103
Phone: 215.656.2458
Fax: 215.656.2498
Email: william.bartow@dlapiper.com

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